

-2-

POU901017US1

REMARKS

Claims 1-32 were originally presented in the subject application. Claims 33 and 34 were added in a Response dated July 2, 2004. Claims 10, 20-22 and 32-34 were canceled without prejudice in an Amendment dated May 23, 2005. No claims have herein been amended, added or canceled. Therefore, claims 1-9, 11-19 and 23-31 remain in this case.

The addition of new matter has been scrupulously avoided.

Applicants respectfully request entry of these remarks, and reconsideration and withdrawal of the sole remaining ground of rejection.

35 U.S.C. §103 Rejection

The final Office Action rejected claims 1-12 under 35 U.S.C. §103, as allegedly obvious over Burk ("UNIX System Administrator's Edition") in view of Deitel ("C & C++ Multimedia Cyber Classroom"). Applicants respectfully, but most strenuously, traverse this rejection.

*Deitel Nonanalogous Art*

The final Office Action includes comments regarding Applicants' nonanalogous art allegation as to Deitel at numbered section 31, subsections a) and b) of pages 16-17. However, the final Office Action fails to describe how the steps of the nonanalogous art test (set forth in the final Office Action itself) are satisfied by Deitel. For example, nowhere therein does the final Office Action explain whether the Examiner takes the position that Deitel is or is not within the Applicants' field of endeavor, nor does the final Office Action set forth any argument in support of either position. As another example, the final Office Action fails to explain how Deitel is reasonably pertinent to the particular problem the present invention seeks to solve.

Since the final Office Action failed to set forth whether Deitel is within the Applicants' field of endeavor (facilitating the searching for text of computer programs by selectively choosing where to search for the text), and if so, explain why, and failed to set forth whether Deitel is reasonably pertinent to the problem Applicants sought to solve (existing text search tools searching too many places, resulting in wasted time and false positives), and if so,

-3-

POU901017US1

explaining how Deitel is reasonably pertinent, Applicants submit that the final Office Action fails to prevent a *prime facie* case of analogous art.

Applicants submit that Deitel is improperly cited against the present application as nonanalogous art.

The determination that a reference is nonanalogous art involves two steps. *Heidelberg Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994); *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (CCPA 1979). First, the reference is reviewed as to whether it is within the field of the Applicants' endeavor. *Id.* Second, if the reference is not in the field of endeavor, then a determination is made as to whether the reference is reasonably pertinent to the particular problem the inventor sought to solve. *Id.*

In determining what the field of endeavor is in the first part of the test, courts have looked to the field of endeavor set out in a patent or patent application. See, e.g., *In re Wood and Eversole*, 202 U.S.P.Q. 171 (CCPA 1979).

In the present case, the field of endeavor in numbered paragraph 0001 of the present application is set out as relating, in general, to searching techniques, and in particular, to facilitating the searching for text of computer programs by selectively choosing where to search for the text. In contrast, Deitel (the actual cited sections thereof) is directed to the “#include” and “#define” preprocessor directives in the C and C++ programming languages. The #include directive (the portion substantively cited) searches for files, not text, and replace the directive with a copy of the file. The same is true even when Deitel is compared to the preamble of claim 1, for example, which recites searching for text of computer programs. Therefore, Applicants submit that Deitel is not within the field of applicant's endeavor.

Since Deitel is not within the field of Applicants' endeavor, it must be determined whether Deitel is reasonably pertinent to the particular problem sought to be solved by the present invention. In this case, as noted in the Background section of the present application, the problem is that existing text search tools search too many places, which is time consuming and tends to produce false positives. Again, though, Deitel is not a text search tool, but describes a

-4-

POU901017US1

preprocessor directive for finding files and replacing the directive with the contents of the file. Thus, Applicants submit Deitel is not reasonably pertinent to the problem sought to be solved.

Therefore, Applicants submit that Deitel is improperly cited against the present application as nonanalogous art.

*Deitel Improperly Combined With Burk*

Moreover, even ignoring the nonanalogous nature of Deitel, Applicants submit one skilled in the art would not combine Deitel with Burk as done in the final Office Action. As an initial matter, Burk is generally concerned with using UNIX, while Deitel is concerned with the C/C++ programming languages. Moreover, the substantively cited section 17.2 of Deitel concerns a directive for file search and insert in preprocessing (i.e., precompiling), whereas GREP in Burk is directed to text searching in computer programs. Applicants submit that one skilled in the art using GREP simply would not look to Deitel to address any issues with text searching in computer programs.

Therefore, Applicants submit that one skilled in the art would not be motivated to combine Deitel with Burk.

*Substantive Rejection*

Even ignoring the nonanalogous nature of Deitel, and the implausible combination of Deitel with Burk, Applicants submit that neither Burk nor Deitel alone, nor their combination, teaches or suggests the presently claimed invention.

Claim 1 recites, for example, determining whether one or more additional items are to be searched for the text, the determining using one or more language specific rules of the computer program to determine whether one or more additional items are to be searched, the determining being defined by the computer program.

Against this aspect of claim 1, the final Office Action cites to Burk at page 145, alleging that repeated use of the FIND command reads thereon. However, it is the user in Burk that

-5-

POU901017US1

determines whether and where to search. The above-noted aspect of claim 1 recites that the determining is defined by the computer program, and not the user as in Burk. Applicants submit that having the ability to search a particular type of item at the command of a user is quite different from a computer program determining whether to search additional items.

Moreover, the determining is also recited to use one or more language specific rules of the computer program. Thus, the computer program determines whether to search additional items based on the language used. Applicants submit this aspect is not taught or suggested by either of the cited references or their combination.

As another example, claim 1 recites searching for the text by the search tool in at least one additional item of the one or more additional items, in response to the determining indicating that one or more additional items are to be searched.

Against this aspect of claim 1, the final Office Action cites to the "#include" preprocessor directive of Deitel. However, as noted above, the #include directive searches for a file and inserts a copy of the file in place of the directive. Thus, the Deitel directive is neither a text search tool, nor does it search the text of a computer program, much less doing so in response to the claimed aspect of determining.

Therefore, for all the reasons noted above, Applicants submit that claim 1 cannot be rendered obvious over Burk in view of Deitel.

Independent claims 11 and 23 include aspects similar to those argued above with respect to claim 1. Thus, the remarks regarding claim 1 are equally applicable thereto. Therefore, Applicants submit that claims 11 and 23 likewise cannot be obviated by Burk in view of Deitel.

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, dependent claim 2 recites that the determining is absent user specification of the one or more additional items. Against claim 2, the final Office Action cites to the following command in Burk:

-6-

POU901017US1

grep-i-n '#include' filename

However, Applicants submit that there is no determining absent user specification in the cited GREP command. The file to be searched is specified by the user within the command, and all statements in that file are searched for the "#include" statement. Applicants submit that no determination is being made about which statements will be searched; all statements are searched within the user specified file if the cited GREP command is present.

Therefore, Applicants submit that claim 2 cannot be rendered obvious over Burk in view of Deitel. In addition, claims 12 and 24 include aspects similar to those argued above with respect to claim 2. Thus, the remarks regarding claim 2 are equally applicable thereto. Therefore, Applicants submit that claims 12 and 24 likewise cannot be obviated by Burk in view of Deitel.

Claim 3 recites that the one or more additional items comprise one or more files. Against claim 3, the final Office Action cites to Burk teaching the FIND command, searching for all file names with a particular name that are printed on the screen.

However, again Applicants submit that no determination is being made regarding whether to search one or more files. If the cited command is present, all files are searched. Applicants submit there is a difference between performing a task as directed by a user (Burk), and a computer program determining whether a task needs to be performed (the present invention).

Therefore, Applicants submit that claim 3 cannot be obviated over Burk in view of Deitel.

Claims 13 and 25 include aspects similar to those argued above with respect to claim 3. Thus, the remarks regarding claim 3 are equally applicable thereto. Therefore, Applicants submit that claims 13 and 25 likewise cannot be obviated over Burk in view of Deitel.

Claim 4 recites that the one or more additional items comprise one or more classes. Against claim 4, the final Office Action alleges that Burk teaches a command for searching classes. However, even assuming, for the sake of argument, that Burk teaches such a command,

-7-

POU901017US1

Applicants submit that no determination *whether* to search one or more additional classes is being made. If the command is present in Burk, the classes would be searched.

Therefore, the Applicants submit that claim 4 cannot be obviated over Burk in view of Deitel.

Claims 14 and 26 include aspects similar to those argued above with respect to claim 4. Thus, the remarks regarding claim 4 are equally applicable thereto. Therefore, Applicants submit that claims 14 and 26 likewise cannot be obviated over Burk in view of Deitel.

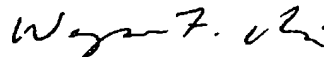
#### CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-9, 11-19 and 23-31.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



Wayne F. Reinke  
Attorney for Applicants  
Registration No.: 36,650

Dated: March 23, 2006.

HESLIN ROTHENBERG FARLEY & MESITI P.C.  
5 Columbia Circle  
Albany, New York 12203-5160  
Telephone: (518) 452-5600  
Facsimile: (518) 452-5579